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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,248	07/31/2001	John Holden Bickford	RSW920010143US1	2799

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EXAMINER

PYZOCHA, MICHAEL J

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,248

Applicant(s)

BICKFORD ET AL.

Examiner

Michael Pyzocha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-11 and 13-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 3-11 and 13-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

1. Claims 3-11 and 13-20 are pending.
2. Amendment filed 03/06/2006 has been received and considered.

Claim Objections

3. The claim objections have been withdrawn based on the field amendment.

Claim Rejections - 35 USC § 112

4. The rejections under the second paragraph of 35 U.S.C. 112 have been withdrawn based on the filed amendment.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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6. Claims 8-9, 13-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Lindeman et al (US 20030009698).

As per claim 8, Lindeman discloses an authentication method for electronic mail, comprising the steps of: receiving, by a recipient, electronic mail from an originator (see paragraphs 83 and 98); responsive to receiving the electronic mail, determining whether an authentication key is expected to be present in an open field of the electronic mail; responsive to determining that the authentication key is expected to be present, determining whether an authentication key is present; and responsive to determining that the authentication key is not expected to be present, accepting the electronic mail (see paragraphs 83-84 and 103-106).

As per claim 9, Lindeman discloses an authentication method for electronic mail, comprising the steps of: receiving, by a recipient, electronic mail from an originator (see paragraphs 83 and 98); responsive to receiving the electronic mail, determining whether an authentication key is expected to be present in an open field of the electronic mail; responsive to determining that the authentication key is expected to be present, determining whether the authentication key is present; responsive to determining that the authentication key is not present, rejecting the electronic mail (see paragraphs 103-106);

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responsive to determining that the authentication key is present, determining whether the authentication key is associated with the originator, responsive to determining that the authentication key is associated with the originator, accepting the electronic mail, and responsive to determining that the authentication key is not associated with the originator, rejecting the electronic mail (see paragraphs 83-84 and 101-103).

As per claim 13, Lindeman discloses an authentication method for electronic mail, comprising the steps of: receiving, by a recipient, the electronic mail from an originator, the electronic mail having been previously prepared for sending from an originator to the recipient (see paragraphs 83 and 98); responsive to receiving the electronic mail, determining whether an authentication key is expected to be present in an open field of the electronic mail; responsive to determining that the authentication key is expected to be present, determining whether the authentication key is present; and responsive to determining that the authentication key is not present in the open field of the electronic mail, rejecting the electronic mail (see paragraphs 103-106).

As per claim 14, Lindeman discloses an authentication method for electronic mail having a subject line, comprising the

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steps of: receiving, by a recipient, the electronic mail from an originator the electronic mail having been previously prepared for sending from an originator with a source identifier to the recipient with a destination identifier (see paragraphs 83 and 98); responsive to receiving the electronic mail, determining whether an authentication key is expected to be present in an open field of the electronic mail; responsive to determining that the authentication key is not expected to be present, accepting the electronic mail; responsive to determining that the authentication key is expected to be present, determining whether the authentication key is present; responsive to determining that the authentication key is present, determining whether the authentication key is associated with both the originator and the recipient; responsive to determining that the authentication key is determined to be associated with both the originator and the recipient, accepting the electronic mail; responsive to determining that the authentication key is determined not to be associated with both the originator and the recipient, rejecting the electronic mail; and responsive to determining that the authentication key is not present, rejecting the electronic mail (see paragraphs 83-84, 103-106 and figures 5-7).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-5, 15, 17-18 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Lindeman in view of Leeds (US 20020016824).

As per claim 3, Lindeman discloses an authentication method for electronic mail, comprising the steps of: preparing electronic mail for sending from an originator to a recipient (see paragraphs 98 and 101); including an authentication key in an open field of the electronic mail (see paragraph 31); and sending the electronic mail from the originator to the recipient.

Lindeman fails to disclose storing and reading an authentication key associated with an originator in a memory of the originator.

However, Leeds teaches such storing and reading of an authentication key (see paragraphs 36 and 37).

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At the time of the invention it would have been obvious to a person of ordinary skill in the art to store and read the authentication key of Lindeman from memory.

Motivation to do so would have been to determine when email is junk email (see paragraph 36).

As per claim 4, the modified Lindeman and Leeds system discloses the open field is the subject line (see Lindeman paragraphs 29 and 31).

As per claim 5, the modified Lindeman and Leeds system discloses the authentication key associated with the originator is further associated with the recipient (see Lindeman paragraph 31).

As per claims 15, 17-18 and 20, the modified Lindeman and Leeds system discloses the authentication key is dependent upon only an identity of the originator (see Leeds paragraphs 36 and 37).

9. Claims 6-7, 10-11, 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Lindeman and Leeds system and further in view of Liu et al (US 6760752).

As per claims 6 and 11, the modified Lindeman and Leeds system discloses an authentication method for electronic mail, comprising the steps of: storing an authentication key in a memory of a recipient of the electronic mail (see paragraph 37);

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receiving, by a recipient, electronic mail from the originator (see Lindeman paragraphs 83 and 98); responsive to receiving the electronic mail, determining whether an authentication key is present in an open field of the electronic mail; responsive to determining that the authentication key is present, determining whether the authentication key is associated with the originator (see Lindeman paragraphs 83-84 and 101); and responsive to determining that the authentication key is not associated with the originator rejecting electronic mail; wherein said determining whether the authentication key is associated with the originator includes reading the stored authentication key and comparing the stored and received authentication keys (see Lindeman paragraphs 83-84, 102 and 103 and Leeds paragraphs 36-37).

The modified Lindeman and Leeds system fails to disclose the address at which the key is stored is dependent upon a source identifier that identifies the originator.

However, Liu et al teaches such addressing (see column 19 line 57 through column 20 line 14).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to store the authentication key of the modified Lindeman and Leeds system in an address dependent upon a source identifier of the originator.

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Motivation to do so would have been store the information in a recovery database (see Liu et al column 19 line 57 through column 20 line 14).

As per claim 7, the modified Lindeman, Leeds and Liu et al system discloses the open field is the subject line (see Lindeman paragraph 29 and 31).

As per claim 10, the modified Lindeman, Leeds, and Liu et al system fails the memory has a flag for determining whether and authentication key is expected.

However, Official Notice is taken that at the time of the invention it would have been obvious to one of ordinary skill in the art to use a flag. Motivation to do so would have been that there are only two possible outcomes.

As per claims 16 and 19, the modified Lindeman, Leeds and Liu et al system discloses the authentication key is dependent upon only an identity of the originator (see Leeds paragraphs 36 and 37).

Response to Arguments

10. Applicant's arguments with respect to claims 3-7 and 10-11 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's arguments filed 03/06/2006 have been fully considered but they are not persuasive. Applicant argues that Lindeman fails to teach the limitations of claims 8-9 and 13-14.

With respect to Applicant's arguments Lindeman discloses a general process flow in figures 4 and 5 and further details this flow in figure 7. In paragraph 83, Lindeman discloses determining if a key is expected to be present, i.e. if the sender isn't approved or trusted. Lindeman also teaches if it is expected and not present rejecting the email in paragraph 84. The details of authenticating the key are disclosed in paragraphs 98-106. Therefore figures 4, 5 and 7 with their descriptions in paragraphs 83-84 and 98-106 disclose the limitations of claims 8-9 and 13-14.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

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statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP


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